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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,930	09/06/2005	Lone Andersen	GRP-0104	6400

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CANTOR COLBURN, LLP
20 Church Street
22nd Floor
Hartford, CT 06103

EXAMINER

CORBIN, ARTHUR L

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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02/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,930	Applicant(s) ANDERSEN ET AL.	
	Examiner Arthur L. Corbin	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03-23&08-29-05,07-26&11-13-06,12-18-07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 23-64 is/are rejected.
- 7) ☒ Claim(s) 3,7,13,17,20,23,24,27,33,37,59 and 60 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date
:032305,082905,072606,111306,121807.

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1. Claims 3, 7, 13, 17, 20, 23, 24, 27, 33, 37, 59 and 60 are objected to because of the following informalities: In claims 3, 27, 33, 37, 59 and 60, "comprises" should be singular. In claim 7, line "atoms" should be singular. In claim 13, line 2, "is" should be added before "selected". In claim 17, line 4, "and" should be added after the comma and line 5, "consisting" should be added after "group". In claim 20, line 2, "is" should be changed to "are" and line 3, "the" should be added after "of". In each of claims 23 and 24, line 2, "the" should be added after "of", and "are" should be changed to "is".

Appropriate correction is required.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17, 20, 58, 59, 61 and 62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis in claim 1 for: "the at least one backbone comonomer" (claim 17), which can be corrected by making claim 17 dependent upon claim 3; "the...polymer" (claim 20, line 2) and "the...initiator" (claim 20, line 3). There is no antecedent basis in claim 25 for: "the...polymer" (claim 58, line 2); "the biodegradable polymers" (claim 59, line 2); and "said...copolymer" (claims 61 and 62, line 3). Corrections are required without new matter.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-16, 23-27, 30-42, 44-50, 55 and 57-64 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Goldberg et al (WO 01/47368, pages 4-7, 9-14, 17, 19). Goldberg et al discloses a chewing gum, free of non-biodegradable polymers (claim 44), including a multifunctional polyol initiator (claims 1, 15, 16), two different monomers, as claimed by applicant (claims 1-10), forming the backbone of a biodegradable chewing gum polymer as claimed by applicant (claims 1, 11, 59-64) in the amounts as claimed by applicant (claims 58-60) and a carbonate monomer, as claimed by applicant (claims 1, 12-14), wherein the monomers have molecular weights and a glass transition temperature within applicant's claimed ranges (claims 9, 23, 24). The chewing gum also includes conventional ingredients, i.e. resins, softeners, sweeteners, flavoring agents, fillers, coloring agents and film forming agents as claimed by applicant (claims 25-27, 30-42, 45-47, 57, 61-63)). The chewing gum in Goldberg et al may be coated with a syrup, which results in a hard or soft coating (applicant's claims 48-50, 55).

7. Claims 17-20, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. Finding the optimum amount of each component

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would require nothing more than routine experimentation by one reasonably skilled in this art.

8. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al in view of Li et al (6,153,231, col. 7, lines 60-61). It would have been obvious to include a pharmaceutical agent in the chewing gum of Goldberg et al since it is conventional to include such an active ingredient in chewing gum, as evidenced by Li et al.

9. Claims 51-54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al in view of Meyers (5,433,960, cols. 3 & 9-13 and claims 1,16, 27). It would have been obvious to coat the chewing gum in Goldberg et al with a coating as claimed by applicant in order to provide storage stability to the chewing gum since it is well known to coat chewing gum products with each of applicant's claimed coating materials in order to achieve this objective, as evidenced by Meyers.

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-64 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-62 of copending Application No. 10/472,122; claims 1-54 of copending Application No. 10/472,154; claims 1-67 of copending Application No. 10/528,926; claims 1-7 and 10-57 of copending Application No. 10/528,927; claims 1-20, 22-26 and 28-42 of copending Application No. 10/529,133; claims 1-55 of copending Application No. 10/529,137 and claims 1, 2, 10, 11, 13-18, 24-26 and 28-54 of copending Application No. 11/088,109, each set of claims being in view of Goldberg et al. It would have been obvious to use a multifunctional polyol initiator to prepare the biodegradable chewing gum polymers claimed in each of said applications since the use thereof is well known in making said polymers, as evidenced by Goldberg et al.


This is a provisional obviousness-type double patenting rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur L. Corbin whose telephone number is (571) 272-1399. The examiner can normally be reached on Monday-Friday from 10:30 AM to 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton I. Cano, can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur L. Corbin
Primary Examiner
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2-27-08